

REMARKS/ARGUMENTS

Claims 1-3 and 7-9 are pending in the present application. The specification is amended herein. Claims 4-6 are canceled herein. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Brunsting (U.S. Patent No. 5,932,108; hereinafter "Brunsting"), and also under 35 U.S.C. 103(a) as being unpatentable over Robinson (U.S. Patent No. 4,446,019; hereinafter "Robinson") in view of Brunsting. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wascher et al (U.S. Patent No. 5,441,647; hereinafter "Wascher") in view of Brunsting. Applicant respectfully traverses the rejections and asserts that Claims 1-3 and 7-9 are in condition for allowance.

Claim Rejections - 35 USC § 102

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Brunsting. Claim 1 requires in part "a rare earth magnet surrounding the rim on the first open end of the [oil] filter." Brunsting fails to teach or suggest a rare earth magnet surrounding a rim on the open end of an oil filter. Instead, Brunsting teaches a magnetic filter assembly 12 having a plurality of magnets 34 contained in a casing 36 (Fig. 1 and col. 5, lines 35-63), and "positioned around the outer surface of the [filter] canister 14" (col. 7, lines 26-27). Brunsting also teaches that "multiple magnetic filter assemblies 12 are preferably used" (col. 7, lines 48-51). However, Brunsting fails to teach or suggest a rare earth magnet **surrounding the rim** of the filter, as Claim 1 requires.

Brunsting teaches a plurality of magnets for creating a magnetic circuit 80 (Fig. 3 and col. 8, line 45 - col. 9, line

54), thus teaching away from a rare earth magnet that surrounds the filter, as required in Claim 1.

Furthermore, Brunsting teaches that "the magnetic assemblies 12 are spaced approximately one-half inch from the top edge of the canister 14 as shown in FIG. 2 so that the generated magnet field is not detrimentally influenced by turbulence as the oil enters the filter body..." (col. 7, lines 56-61), thus teaching away from a rare earth magnet **surrounding the rim** of the filter, as Claim 1 requires. Additionally, Figure 1 illustrates that the magnetic assemblies 12 taught by Brunsting do not independently surround the filter canister 14, as Claim 1 requires.

For at least the above reasons, Applicant respectfully asserts that the rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by Brunsting is traversed, and that Claim 1 is in condition for allowance. Claims 2 and 3 are dependent on Claim 1 and recite additional limitations, therefore Applicant asserts that the rejection of Claims 2 and 3 under 35 U.S.C. 102(b) as being anticipated by Brunsting is also traversed, and that Claims 2 and 3 are also in condition for allowance.

Claim Rejections - 35 USC § 103

Claims 1-3

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Brunsting. Claim 1 requires in part "a rare earth magnet **surrounding the rim**" on the open end of an oil filter. In contrast, Robinson teaches "a non-continuous, flexible ring-like element 40" (col. 4, lines 55-56), that "may be snapped into position on the annular surface area 39 [between the shoulder 38 and the outermost part of each inlet opening 30] and held against the shoulder 38 as

the ring 40 flexes to its original diameter" (Figure 4 and col. 4, lines 50-61). The ring-like element 40 taught by Robinson is held in place by its inherent spring property against the interior of the rim 38 of the filter, while Claim 1 requires that the magnet surrounds the rim. It would not have been obvious to one of ordinary skill in the art, in view of Robinson, to construct a rare earth magnet that surrounds the rim on the open end of an oil filter, as required in Claim 1.

Brunsting teaches a rare earth magnet, but fails to remedy the deficiency of Robinson with respect to Claim 1, discussed above. Applicant respectfully asserts that combining the rare earth magnet taught by Brunsting with the ring-like metallic element 40 taught by Robinson does not render the invention as recited in Claim 1. Furthermore, neither Brunsting nor Robinson suggest that rare earth magnetic material can be used to form a non-continuous, flexible ring-like element 40 as Robinson discloses. Applicant respectfully asserts that the rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Brunsting is traversed, and that Claim 1 is in condition for allowance. As Claims 2 and 3 are dependent on Claim 1 and recite additional limitations, Applicant respectfully asserts that the rejection of Claims 2 and 3 under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Brunsting is traversed, and that Claims 2 and 3 are also in condition for allowance.

Claims 4-9

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wascher in view of Brunsting. Claims 4-6 are canceled herein. Claim 7 requires a filter having a closed end "formed from a rare earth magnet." In contrast, Wascher teaches

a sleeve (30, 40, 52) having a well 38 for receiving an oil filter canister 12, and a magnet (34, 46, 58) contained within a pocket (36, 42, 60) at the bottom of the well 38 (Figs. 2A, 3A and 4A, and col. 3, line 66 - col. 4, line 19). Wascher fails to teach or suggest a filter having a closed end "formed from a rare earth magnet," as required in Claim 7, and instead teaches various sleeves for fitting over the bottom of a filter canister to bring a magnet into close proximity with the bottom of the filter canister. It would not have been obvious for one of ordinary skill in the art to form the closed end of the filter out of a magnet, as required in Claim 7.

As noted by the Examiner, Wascher also fails to teach or suggest a rare earth magnet, as required in Claim 7. While Brunsting teaches rare earth magnets, Applicant respectfully asserts that even if the magnets taught by Wascher were formed of rare earth magnetic material, the result would not be the invention as recited in Claim 7.

Applicant respectfully asserts that the rejection of Claim 7 under 35 U.S.C. 103(a) as being unpatentable over Wascher in view of Brunsting is traversed, and that Claim 7 is in condition for allowance. Claims 8 and 9 depend from Claim 7 and recite additional limitations, therefore Applicant asserts that the rejection of Claims 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over Wascher in view of Brunsting is also traversed, and that Claims 8 and 9 are in condition for allowance.

CONCLUSION

In light of the response presented herein, Applicant respectfully asserts that Claims 1-3 and 7-9 of the present application overcome the rejections of record, and therefore earnestly solicit allowance of these claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

No fees or extensions of time are believed to be due in connection with this response. However, consider this a request for any fee or extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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